



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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(H)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/932,834 09/18/97 PORUBEK

D 077319/0129

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WASHINGTON DC 20007-5109

HM12/0607

EXAMINER

BERCH, M

ART UNIT

PAPER NUMBER

1611

31

DATE MAILED:

06/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

08/932,834

Applicant(s)

Porubek

Examiner

Mark L. Berch

Group Art Unit

1611



## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on May 27, 1999 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on May 27, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

- ☒ will not be entered because:

- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See Memo

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: \_\_\_\_\_
- Claims objected to: \_\_\_\_\_
- Claims rejected: 1-7 and 9-27
- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

MARK L. BERCH  
PRIMARY EXAMINER  
ART UNIT 1611

Art Unit: 1611

### DETAILED ACTION

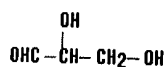
Applicants are again reminded of the proper form for tendering amendments. The amendment to the claims should be made in accordance with 37 CFR 1.121(a)(2)(ii) which states:

(ii) Claim cancellation or rewriting: A claim may be amended by directions to cancel the claim or by rewriting such claim with underlining below the matter added and brackets around the matter deleted.

The third species in claim 14 was simply altered without either deleting the old formula or underlining the new.

The amendment cannot be entered:

- A. The narrowing of the  $R_4$  definition on page 3 introduces a problem for  $X = P$ . This new formula gives a 4-valent P, which is impossible unless the P carries a charge, and no such charge is indicated.
- B. Claim 5 would no longer limit, and the "at least one" of claims 5, 11 and 17 would no longer make sense. Similarly, claims 22 and 26-27 would no longer limit.
- C. Some of the new terms added are unclear. For example "glyceraldehyde" is as follows:



Which H is to be removed to make the moiety? One from the OH, and if so which one? From a C, and if so, from the aldehyde carbon, a secondary or tertiary carbon? What is ribolucosyl? The term "glucosidyl" is a broad one with unclear scope, and may embrace others on the list. And other terms may be unclear as well.

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The amendment, if entered, would not have taken care of points 1, 2 listed on page 2.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

A handwritten signature in black ink, appearing to read "Mark L. Berch", written in a cursive style.

Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1611

June 2, 1999